

REMARKS

In the specification:

Editorial changes have been made in the specification to refer to new FIG. 4, which provides a block flowchart of the wagering process and distribution of sweepstakes entry forms. The brief description of the drawings has also been revised to reflect the addition of this new figure.

In the drawings:

A block diagram has been added (FIG. 4) to show the method steps of claims 1, 3-4, 7, 14, 16, and 27-36 to comply with the Examiner's objection.

In the claims:

Claims 1, 3, 4, 14, 16, 18, 20, 21, and 27-36 remain in the application for further prosecution. Please cancel claims 7 and 24. Claims 2, 5-6, 8-13, 15, 17, 19, 22-23, and 25-26 have been previously canceled. Claims 1, 14, 18, 27, 28, 31-34, 36 have been amended.

Claim 24 was objected to because of the form of the preamble. This objection is moot through the cancellation of claim 24.

ARGUMENTS

A. Claim Rejections – 35 U.S.C. § 102 as being anticipated by Moody

Claims 1, 14, 18, 27, and 31-32 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0093136 to Moody ("Moody"). The Office Action alleges that Moody discloses the invention. The Applicant respectfully disagrees on the basis that significant claim limitations are presents in the cited claims that are missing from Moody.

Not All Claim Limitations Taught or Suggested

To establish anticipation a single prior art reference must, either expressly or inherently, describe each and every element set forth in the claim. Certain claim limitations included in claims 1, 14, 18, 27, and 31-32 are missing from Moody and are addressed below.

✓ The Office Action states that Moody discloses “submitting the sweepstakes entry to enter the sweepstakes without involving the gaming machine” (Office Action, page 3). Moody, however, does not disclose requiring a player to complete a sweepstakes entry form before submitting the sweepstakes entry.

Moody states that the electronic gaming machine, “also includes a printer device which would print out and make available to the player a sweepstakes ticket . . .” (Moody, paragraph 19). Moody does not require the player to complete the ticket with identifying indicia, nor to submit the ticket in order to enter the game. Moody states, “If the player has a winning lottery ticket, the player could redeem the winning lottery ticket in the same manner that the player would redeem a winning lottery ticket the player had purchased directly, rather than having won the lottery ticket playing a gaming machine.” (Moody, paragraph 48). Buying a lottery ticket directly does not require the player to fill out a form on the lottery ticket to become eligible for winning the lottery. Mere possession of the ticket is sufficient to enter the player into the game and to redeem the ticket for a winning award.

The gaming machine also preprints Moody’s keno ticket with player selections as described by Moody in paragraphs 42-46. The player is not required to fill in any information on Moody’s keno tickets. Moody states, “The player could participate in the keno game for which the keno ticket is associated by watching the keno game outcome as it is displayed on the keno

number boards . . . as is conventional.” (Moody, paragraph 42). Entry into Moody’s keno game is automatic (as is the case for all the embodiments described by Moody).

The claimed invention is in sharp contrast with Moody’s preprinted tickets. Independent claims 1, 14, 18, 27, and 31-32, require, “completing the tangible sweepstakes entry form manually with identifying indicia.” Moody is missing this limitation: the manual completion of the entry form.

Another limitation, included in claims 1, 14, 18, 27, and 31-32 - but missing from Moody - requires, “submitting the sweepstakes entry form to enter the sweepstakes without involving the gaming machine.” These claims require, “submitting the sweepstakes entry form to enter the sweepstakes without involving the gaming machine.” The player must fill out the sweepstakes entry form before the player can become eligible to win the sweepstakes.

Moody is silent with respect to requiring the submission of a sweepstakes entry form, or for that matter, any ticket to enter and become eligible to win an award. In fact, Moody teaches away from the present invention by dispensing a ticket that automatically enters the player into another gaming event. This automatic entry of the ticket into a gaming event is described for both lottery and keno tickets as discussed above. (Moody, paragraphs 41-49).

Consequently, as all the independent claims, and by inclusion all the dependent claims, contain two separate and substantial limitations that are not disclosed by Moody, Applicant submits that either of these two missing limitations overcomes the 35 U.S.C. § 102(e) rejection. Furthermore, Applicant submits that manually completing a sweepstakes entry form dispensed from a gaming machine is a novel and non-obvious feature over Moody.

B. Claim Rejections – 35 U.S.C. § 102 as being anticipated by Horniak

Claims 28-30 and 34-36 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0100362 to Horniak (“Horniak”). The Office Action alleges that Horniak discloses the invention. The Applicant respectfully disagrees on the basis that significant claim limitations are missing from Horniak.

Not All Claim Limitations Taught or Suggested

To establish anticipation a single prior art reference must, either expressly or inherently, describe each and every element set forth in the claim. Independent claims 28 and 34 and by inclusion dependent claims 29-30 and 35-36 require, “completing the tangible sweepstakes entry form manually with identifying indicia.” The same claims also require, “submitting the sweepstakes entry form to enter the sweepstakes without involving the gaming machine.” These claim limitations are missing from Horniak.

The Office Action states that Horniak discloses “dispensing a tangible sweepstakes entry from the gaming machine, . . . submitting the sweepstakes entry to enter the sweepstakes without involving the gaming machine, and conducting the sweepstakes after the sweepstakes entry is dispensed from the gaming machine.” (Office Action, page 4).

Horniak, however, is silent with respect to any type of sweepstakes event. Horniak fails to describe any type of sweepstakes event, including, “completing the tangible sweepstakes entry form manually with identifying indicia” as required by all the independent claims. Furthermore, Horniak fails to describe “submitting the sweepstakes entry form to enter the sweepstakes without involving the gaming machine” as also required by all the independent claims. In fact, Horniak is silent with respect to any method or description of redeeming tickets issued by the gaming machine that Horniak describes.

Consequently, as Horniak is missing these two fundamental limitations, Applicant submits that either of these two missing limitations overcomes the 35 U.S.C. § 102(e) rejection. Furthermore, Applicant submits that manually completing a sweepstakes entry form dispensed from a gaming machine is a novel and non-obvious feature over Horniak.

C. Claim Rejections - 35 U.S.C. § 103 Over Moody in view of Horniak

Claims 3-4, 16, and 20-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. publication number 2002/0093136 Moody (“Moody”) in view of U.S. publication Number 2003/0100362 to Horniak (“Horniak”).

Not All Claim Limitations Taught or Suggested

One basic requirement for a *prima facie* case of obviousness is that the prior art references must teach or suggest all of the claim limitations. “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” See M.P.E.P. § 2143.03. Moody in view of Horniak does not satisfy this requirement.

Claims 1, 3-4, 14, 16, 18, and 20-21 all require: 1) “completing the tangible sweepstakes entry form manually with identifying indicia” and 2) “submitting the sweepstakes entry form to enter the sweepstakes without involving the gaming machine.”

This is in sharp contrast to Moody, which dispenses a preprinted ticket that immediately and automatically qualifies the player for a gaming event. Moody describes this automatic entry into a gaming event for both lottery and keno tickets. (Moody, paragraphs 41-49).

Moody is silent with respect to requiring the submission of a sweepstakes entry form, or for that matter, any ticket to enter and become eligible to win an award. Moody is also silent with respect to providing identifying indicia on the ticket. The automatic entry of the ticket into the gaming event precludes the need for the player to provide identifying indicia on the ticket in

order to become eligible for the game event. Consequently, Moody is missing two fundamental limitations: completing the tangible sweepstakes entry form manually with identifying indicia and submitting the entry form to become eligible for the drawing.

Horniak, likewise, does not describe or suggest completing an entry form, nor submitting the entry form to become eligible for the game event. Horniak only states that, “The dispensed tickets can then be redeemed for prizes, utilized for additional gambling, and/or used for whatever reward purposes the casino or other establishments decide.” (Horniak, paragraph 11). Horniak, is not only silent with respect to manually completing an entry form with identifying indicia, but furthermore, is silent with respect to any type of sweepstakes or lottery game event.

These missing limitations are significant and fundamental limitations that affect casino business operations. In particular, these limitations affect the gaming establishment’s ability to procure sales and marketing information. Requiring players to provide identifying indicia to become eligible for the game events provides the gaming establishment with a wealth of sales and marketing information. The completed sweepstakes entry form also helps protect the player against loss or theft of the ticket.

Neither Moody or Horniak describe or suggest the limitations contained in each independent claim requiring 1) “completing the tangible sweepstakes entry form manually with identifying indicia” and 2) “submitting the sweepstakes entry form to enter the sweepstakes without involving the gaming machine.” Because these missing limitations are not taught or suggested by the references, and consequently, a *prima facie* case of obviousness has not been established. Applicant respectfully submits that claims 1, 3-4, 14, 16, 18, and 20-21 are patentable over Moody in view of Horniak under 35 U.S.C. § 103.

D. Claim Rejections - 35 U.S.C. § 103 Over Moody in view of Brandstetter

Claims 7 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. publication No. 2002/0093136 Moody ("Moody") in view of U.S. publication No. 2003/0036427 to Brandstetter ("Brandstetter"). The Office Action states that, "Brandstetter teaches dispensed tickets having preprinted identifying indicia." Brandstetter, however, only teaches preprinted game related indicia – not identifying indicia. Despite this, however, claims 7 and 24 have been canceled to expedite the approval of the remaining claims. Applicant reserves the right to file one or more continuation applications seeking protection for such claims or claims of similar scope.

Conclusion

It is the Applicant's belief that all of the claims are now in condition for allowance, and action towards that end is respectfully requested. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

Respectfully submitted,

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